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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,613	12/13/2001	Eric D. McAfee	42390.P12029	7665
8791	7590	02/02/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			SAETHER, FLEMMING	
			ART UNIT	PAPER NUMBER

3679

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,613

Applicant(s)

MCAFEE, ERIC D.

Examiner

Flemming Saether

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gulistan (US 3,346,032). Gulistan discloses an apparatus comprising a cylindrical ferrule (12) having a channel therethrough, a first end having a capture extension flange (15) and, a second end having a "soldering" extension (18). A screw (10) protrudes through the channel and includes a head (30) with an overmold (13) having an extension (16) which cooperates with the capture extension holding the screw to the ferrule (see Fig. 2). Gulistan also discloses a spring (11).

Claim Rejections - 35 USC § 103

Claims 1, 2, 4-8, 13, 15-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gulistan in view of DiBene (US 5,785,449). Gulistan discloses a captive screw apparatus as described above however, does not disclose the apparatus soldered to a printed circuit board (PCB). In the embodiment of Fig. 4, DiBene also discloses a captive screw apparatus and method wherein the captive screw apparatus is connected to a PCB and further disclose connection accomplished by a soldering method (column 6, line 54). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the captive screw apparatus disclosed in Gulistan for fastening a PCB as disclosed in DiBene because the captive screw apparatus of Gulistan is superior in that it is "both simple and economical to manufacture, and readily installed and used". The advantageous design of Gulistan's captive screw apparatus would have been recognized to be used in variety of

applications including in combination with PCBs. Inherently, the channel and a mounting hole in the PCB would have to be aligned for the device to be operative.

Claims 3, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gulistan or Gulistan in view of DiBene as applied to claims 1, 9, 13 17 and 18 above and further in view of Schwarz (US 5,743,692). Schwarz discloses a ferrule to have a flange (46) for soldering. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the ferrule of Gulistan and Gulistan as modified by DiBene with a flange as disclosed in Schwarz in order to facilitate soldering. The flange would provide a larger surface area to provide a better solder bond.

In response to Remarks:

As evident by the above rejection, even after carefully considering applicant's remarks, the rejections have been maintained.

Applicant initially argues that the 102 rejection applied to claims 9-12 cannot be sustained because Gulistan does not disclose a "soldering extension". In response, the examiner disagrees because simply calling an extension a "*soldering* extension" add no further structure to the extension. Indeed, "soldering" is a method limitation which at best could be interpreted as an intended use limitation in the article of claims 9-12 and in article claims, the prior art only needs to be capable of the intended use to meet the

limitation. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With that in mind, the Gulistan reference reads on the claims since the extension disclosed therein would be capable of soldering.

Applicant next argues the 103 rejection cannot be sustained because DiBene does not disclose the soldering of any apparatus to a PCB. Applicant goes on that in DiBene the apparatus is soldered to a “front panel” which presumable applicant does not consider to be part of the PCB. In response, the examiner disagrees because with the claims given their broadest reasonable interpretation the “front panel” is a part of the PCB. Even in DiBene, the front panel is repeatedly referred to as the “front panel 12 of printed circuit board 14” [emphasis added] thus implying it is a part of the printed circuit board or PCB. Furthermore, there is nothing in the claims which would preclude reading the front panel, as an part of a PCB regardless of is configuration. Lastly, the supposed error to DiBene Fig. 3 is irrelevant to the rejection but, applicant is reminded that the figures can be used as a reference for what they fairly show regardless of if it is in error or not. See *In re Mang*, 181 USPQ 94, 97 (CCPA 1974).

Applicant lastly argues that in Schwarz, the flange is for welding and not for soldering whereas the claims of the instant invention require soldering. In response, the examiner agrees but, the reference to Schwartz is not relied upon for teaching soldering since such is taught in DiBene. Schwartz is only relied upon to teach a flange providing a surface.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Flemming Saether
Primary Examiner
Art Unit 3679